

RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK L. YOSELOFF and ROGER M. SNOW

Appeal 2007-2074
Application 10/658,863
Technology Center 3700

Oral Hearing Held: July 12, 2007

MAILED

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before HUBERT LORIN, JENNIFER BAHR, and WILLIAM PATE, III
Administrative Patent Judges

ON BEHALF OF THE APPELLANT:

MARK A. LITMAN, ESQUIRE
Mark A. Litman & Associates
York Business Center
Suite 205
3209 West 76th Street
Edina, Minnesota 55435

35 The above-entitled matter came to be heard on July 12, 2007,
36 commencing at approximately 9:47 a.m., at the United States Patent and
37 Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Elizabeth
38 J. Walker, Reporter.

1 USHER: Calendar Number 26,

2 Mr. Litman.

3 JUDGE PATE: Good morning, Mr. Litman.

4 MR. LITMAN: Good morning, sirs.

5 JUDGE PATE: We've had a chance to look over your case
6 beforehand, so we're familiar with some of the details and we're ready to
7 hear your argument.

8 MR. LITMAN: Very good. Thank you very much. There are
9 basically three issues in the appeal in this case.

10 First I would like to go into the background of the technology itself, to
11 give you an appreciation of what the differences are in the art.

12 In the present case, it is a wagering game in which first a partial hand
13 is provided to the player. There are two separate bets made by the player.
14 One for a game against the pay table for the partial hand, and the second bet
15 is for a game bet against the house, the house hand, based on a completed
16 hand for the player.

17 So there are two separate wagers, and two different hands that are
18 being bet on; one a partial hand and one a complete hand.

19 The primary reference being cited in the case, DeKeller, shows a
20 game in which there are two mandatory bets, both for complete hands, both
21 for the same hand being complete.

22 The two wagers are for one, a wager for a pot game, in which each

1 player at the table is making contribution to a pot, and they are playing
2 player versus player, with a complete hand.

3 The second wager is against the pay table for the complete hand. And
4 in both games, the wager is for a complete hand.

5 Claim one on appeal, rejected under 35 U.S.C. 102, states that there is
6 a partial hand provided to the player.

7 The second wager is against a pay table for the partial hand, and then
8 community cards are provided to make a complete hand.

9 And the second wager is on the complete hand.

10 DeKeller cannot anticipate that claim, period. DeKeller never has a
11 wager on a partial hand, and that hand being subsequently completed to form
12 a hand that is used in a pot game.

13 DeKeller always has the same hand, whether it's five cards, or four
14 cards, or three cards in the actual play of this game. The same complete
15 hand is used as the hand in competition for the pot and against the pay table.

16 At no time are the two distinct hands a partial hand being played
17 against the pay table, and then a subsequent completed hand being played
18 against the dealer or any other player.

19 DeKeller cannot anticipate claim one. No claim dependent therefrom
20 can be anticipated.

21 JUDGE LORIN: May I stop you, Counsel, for a second? I have a
22 question about your claimed construction.

1 MR. LITMAN: Could you speak up? I have been flying too much
2 and I --

3 JUDGE LORIN: I have a question about your claimed construction.

4 MR. LITMAN: Yes.

5 JUDGE LORIN: You have a step here that says, optionally placing a
6 side bet for the second poker-type game.

7 MR. LITMAN: Right.

8 JUDGE LORIN: From the way I understand your argument, is that
9 this claim requires.

10 MR. LITMAN: Well, at an absolute minimum, you have the option
11 as a step in the game, it's a positive recitation of the step that has, will you
12 make this bet or will you not on a partial hand for the bet.

13 This claim does not cover a game in which only a single bet can be
14 made in a game. There is a positive active recitation in the claim for the
15 option of making that bet.

16 You have to positively and definitively consider, am I going to make
17 an option or am I not?

18 If you do not do that it does infringe the claim. That is a positive step,
19 even though it's an option.

20 That is an absolute limitation here. Otherwise, this claim would be
21 absolutely nothing more than a bet against the house.

22 That's an absurd reading of the claim. We have never argued it to

1 include that. No one should possibly interpret that the option is a positive
2 recitation of a step exercised by the player in the performance of the game.

3 JUDGE LORIN: If we were to read it that way, that there's a positive
4 step requiring an option for the second poker game --

5 MR. LITMAN: Right.

6 JUDGE LORIN: -- are you saying DeKeller does not have that
7 option?

8 MR. LITMAN: I still can't hear you. I'm very sorry.

9 JUDGE LORIN: Are you saying that DeKeller does not have that
10 option?

11 MR. LITMAN: Well, not only does he not have that option, he has
12 two mandatory bets. Two bets are mandatory.

13 But more importantly, the bet that he makes against the pay table is
14 for the complete hand, not a partial hand.

15 And the option bet that we have is for a partial hand. DeKeller has
16 two bets, both for the total cards in his hand at the conclusion of the delivery
17 of all cards to the player.

18 He never bets a partial hand. DeKeller has a pot bet, player against
19 player, for the totality of the cards in every player's hand.

20 He also has a bet against the pay table for the totality of the cards in
21 the final hands of the player.

22 So in both cases, there is never a wager on a partial hand.

1 And in our claim we recite that after receiving the partial hand
2 additional cards are provided in the form of community cards to be used in
3 the other bet.

4 So clearly, two different events are taking place. And remember, and
5 I emphasize this, DeKeller has been cited against claim one in 35 USC 102,
6 and DeKeller does not show a bet on a partial hand.

7 I will move on to another argument, because I'd love to get to this, and
8 that is the fact that we have priority for the claimed subject matter in this
9 case for a date earlier than DeKeller.

10 The Examiner has pointed out a single basis for refuting antecedent
11 basis for that claim, and that is the fact that he says in the earlier case you
12 showed the use of a wild card that is used by all the hands, and a wild card is
13 not a community card. That is totally false.

14 We have shown, by accepted practice in the art, with five Patents
15 issued through the U. S. Patent and Trademark Office, prior to our filing
16 date, commercial literature in the game of Pogo.Com and the play of Texas
17 Hold-'Em with wild cards where wild cards appearing in the flop, 4th Street,
18 or the river card are community cards, even if they are wild.

19 And also literature out of Ainsley which shows that a wild card can be
20 used as a community card.

21 Since the Examiner has refuted our antecedent basis for which we've
22 set down a table showing the basis for each and every limitation in our

Appeal 2007-2074
Application 10/658,863

1 claim, he has refuted that basis solely on the ground that a wild card cannot
2 be a community card, and we have shown that this is an error in the art, that
3 the art commonly accepts the fact that a single wild card or one wild card
4 amongst other community cards can be a community card.

5 The Examiner's refusal to accept our basis of priority is wrong.

6 DeKeller is not available as prior art. The fact that DeKeller is there in
7 every single rejection means that every single rejection must fail, because
8 we have established priority from the earlier Application.

9 JUDGE LORIN: Let me stop you for a second, Counsel.

10 MR. LITMAN: Okay.

11 JUDGE LORIN: Do you know what the effective filing date is on
12 this Application?

13 MR. LITMAN: For what case, our priority?

14 JUDGE LORIN: No, your case, the one that's on appeal.

15 MR. LITMAN: 1997. And we have quoted the text of that case, and
16 the basis for --

17 MR. LORIN: Well, let me stop you, Counsel. You said the effective
18 filing date --

19 MR. LITMAN: I want to make sure I'm stating the date correctly. In
20 our reply brief I think -- our reply brief, the original brief -- okay. It goes
21 back to July 19, 1995, is the text that we are quoting from our priority date,
22 and the priority date for the DeKeller reference is September 11, 1995, and

1 therefore, two months earlier on the basis of priority.

2 JUDGE LORIN: The Examiner rejected the claims under 102(b). Is
3 that your understanding?

4 MR. LITMAN: Yes.

5 JUDGE LORIN: 102(b). How did the Examiner determine the date
6 so that DeKeller would be a 102(b) reference?

7 MR. LITMAN: He ignored our priority date, and he therefore said,
8 since you don't have priority going back to the earlier Application, therefore
9 your priority is later than DeKeller, because I won't give you the priority
10 date.

11 And therefore, he may be wrong in the citation 102(b) also.

12 He was giving us only the filing date for the present Application as
13 the basis for priority in this case.

14 JUDGE LORIN: Right. I'm sure that's what he did. Now wouldn't
15 the burden shift to you to then explain why you would deserve benefit under
16 120 for each Application in the chain since 1995?

17 MR. LITMAN: Yes. We should receive benefit for the Applications.
18 He is only refuting, in fact, the priority from the July 1995 case.

19 JUDGE LORIN: The Examiner cited a reference and you responded
20 by establishing that your earliest case deserves benefit under 120.

21 MR. LITMAN: Right.

22 JUDGE LORIN: But I read here, I see one, two, three, four -- there

1 are five Applications between the present one and the one you are arguing.

2 MR. LITMAN: The intermediate case actually contains specifically
3 the term, community card. It was this case that was the focal point, and he is
4 focused on this case only.

5 The other cases incorporated by reference this Application, claimed
6 priority from it, and it was only the substantive content of this Application
7 that he was using as a basis for refusing the priority date.

8 JUDGE LORIN: Is this something that was argued earlier on
9 prosecution, because I don't see that in the brief.

10 MR. LITMAN: No. Let me check also the basis for -- all right.
11 Well, to begin with, one of the earlier Patents is a division of the earliest
12 Patent, the July 1997 case, the Texas Stair, is identical to the later one.

13 The subsequent ones are continuations in part, which I believe added
14 additional subject matter to the cases without removing anything there.

15 So in fact, the content of these later Applications contained more than
16 the earlier Application and the Examiner never challenged the content of the
17 intermediate Applications, so I was addressing the arguments that the
18 Examiner was making.

19 The Examiner raised the single issue, wild cards cannot be community
20 cards; I will not give you that priority date.

21 He has never challenged the efficacy of any of the other claims in
22 priority through the other cases, and the other cases did, in fact, as I said, add

1 subject matter to the earliest one.

2 The critical element in the mind of the Examiner that he was raising
3 was the case that we needed for priority. The July 19, 1995, Application did
4 not provide antecedent basis because it had a wild card, or whatever he
5 wanted to call it, available to all players and not calling it a community card.

6 But again, I'd like to point out even if we do not have that basis for
7 priority, and I firmly believe we do, and there is nothing in the record that
8 has challenged that effectively, it doesn't anticipate the subject matter of the
9 claim, because DeKeller does not show wagering on a partial hand,
10 completing that hand and having a separate wager on a complete hand.

11 And since it's been cited under 102, there is no flexibility under any
12 basis whatsoever saying you could modify it, you could change it, you can
13 argue the definition of the terms.

14 DeKeller does not show wagering on a partial hand.

15 All he shows is wagering on a complete hands.

16 JUDGE LORIN: On this latter point, DeKeller is also used
17 under 103.

18 MR. LITMAN: Only against some of the claims. And with regard to
19 some of the claims, the reference cited in supplement of the 103 rejection
20 does not teach wagering on a partial hand.

21 What he does teach, Breeding, is betting on a complete hand only.
22 Breeding is the original Let-It-Ride case. And in the Let-It-Ride case, you

1 are dealt three cards and two community cards, but the only wagers are on
2 the completed hands.

3 There is no wager on a partial hand. In the game of Let-It-Ride you
4 are dealt -- each player is dealt three cards and then there are two community
5 cards for the entire field.

6 A player has three bets that he places down. After looking at his cards
7 he may be allowed to withdraw one of the bets of the three before any
8 community cards are drawn.

9 There is no resolution of the bet at that point. He is betting on his
10 completed hand.

11 He can withdraw his bet or leave it in play.

12 The dealer turns over a community card. The players -- all the
13 players, again, have an option of withdrawing a second bet or letting it ride;
14 hence the name of the game.

15 Again that bet is on the completed hand. He decides to bet or not bet.

16 The third community card is turned over and all three bets are bet only
17 on the completed hand.

18 There is an optional side bet on high-ranking hands against the pay
19 table only on the completed hand. There is no bet on a partial hand. There
20 is no resolution of a bet on a partial hand. All bets are on the completed
21 hand.

22 JUDGE PATE: It pays to be a gambler.

1 MR. LITMAN: And know your games.

2 JUDGE LORIN: I want to get something straight here. DeKeller has
3 been applied against all the independent claims alone, under 102 or in the
4 alternative under 103.

5 MR. LITMAN: Yes.

6 JUDGE LORIN: Understand 102, as I understand your argument,
7 DeKeller shows a second bet on a full hand.

8 MR. LITMAN: Yes.

9 JUDGE LORIN: Whereas you are claiming a second bet on a partial
10 hand.

11 MR. LITMAN: And only a partial hand. We talk about in the claim
12 that you are dealt a partial hand, then subsequent cards are provided so that a
13 complete hand is formed.

14 So the partial hand can never be confused with a completed hand.

15 JUDGE LORIN: Okay. So DeKeller, you would concede, shows a
16 second bet on five cards, the full hand.

17 MR. LITMAN: Yes.

18 JUDGE LORIN: And you would be claiming a second bet on less
19 than five cards.

20 MR. LITMAN: Yes. It has to be.

21 JUDGE LORIN: Under 102 your argument would be because your
22 second bet is four cards, and DeKeller is five cards, it would not anticipate,

1 because it's not identical.

2 MR. LITMAN: Even more than just the number of cards is the order
3 of placement of the cards and the relationship of the cards being provided.

4 Because we point out in our claim you are dealt a partial hand. That's
5 the initial hand given to a player.

6 For example, I don't know if you are card players. If you are dealt --
7 well, let's use something simple. Playing Black Jack, dealt two cards at
8 Black Jack. Those would be considered, at most, a partial hand.

9 And then a second portion of the game is, after you've completed
10 Black Jack you will then play Poker. You are allowed three more cards.

11 You can bet, for example, on two-card Poker win for your Black Jack
12 hand.

13 Then you get additional hands. A partial hand always remains the
14 same. It never changes, because those are the first cards dealt and that's the
15 partial hand.

16 Anything else after that is done to complete the hand.

17 In our game we not only require a bet on a partial hand, but also the
18 provision of additional cards to complete a further hand.

19 There is no option against getting additional cards. The mandatory
20 bet is on the completed hand. The optional bet and the option of placing that
21 bet, which must be exercised in the play of our game, is on the partial hand.

22 Okay?

1 JUDGE LORIN: Okay. Now going back to your question about -- to
2 the question of priority.

3 MR. LITMAN: Yes.

4 JUDGE LORIN: Am I correct that that 1995 Application is to an
5 inventor named Webb?

6 MR. LITMAN: I cannot hear you.

7 JUDGE LORIN: Am I correct in that the 1995 Application is to an
8 inventor Webb, sole inventor Eric J. Webb?

9 MR. LITMAN: We were given priority -- we had priority, continuous
10 priority all the way through the cases.

11 JUDGE PATE: He is just asking about the inventive entity right now.

12 MR. LITMAN: Oh, the inventive entity includes Mark Yoseloff --
13 not Mark Yoseloff, but -- I don't have the full -- who is the inventive entity
14 here? I'm pretty sure John Breeding is --

15 JUDGE LORIN: Our records only show a Mark Yoseloff and a
16 Roger Snow.

17 MR. LITMAN: All right.

18 JUDGE PATE: And our records show that the original Application
19 was to Webb, the original 1995 Application.

20 We can't figure out why there's not a misjoinder here, because if you
21 are relying on that '95 Application for priority for the claimed subject matter,
22 then Webb's contribution is claimed in this Application, and he's not named

1 as an inventor.

2 MR. LITMAN: I was not aware of that issue.

3 JUDGE PATE: It just came up in our discussions that it looks like it's
4 a possible misjoinder. And that would be another thing that the Examiner
5 would need to check on, when the prosecution would continue.

6 MR. LITMAN: I can tell you that -- well, that's a separate issue. I
7 won't even get into that.

8 Okay.

9 JUDGE PATE: Is that all you have?

10 JUDGE LORIN: That's all I have. Thank you, Counsel.

11 MR. LITMAN: Thank you.

12 JUDGE PATE: I have no further questions. We are going to take
13 this case under advisement.

14 Do you have a business card for the court reporter, please?

15 JUDGE PATE: Thank you for your presentation, Counselor.

16 MR. LITMAN: Thank you very much.

17 JUDGE PATE: Good day.

18 MR. LITMAN: Good day.

19 Whereupon, at approximately 10:09 o'clock a.m., the hearing in the
20 above-entitled matter was concluded.